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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,547	12/28/2001	Naveen Agarwal	15546	1410

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EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/21/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/034,547

Applicant(s)

AGARWAL ET AL.

Examiner

Aaron Roane

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 14-20 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: Species #1 characterized by figures 1 and 1A, Species #2 characterized by figures 2 and 2A, Species #3 characterized by figures 3 and 3A, Species #4 characterized by figures 4 and 4A, Species #5 characterized by figures 5 and 5A, Species #6 characterized by figures 6 and 6A, Species #7 characterized by figures 7 and 7A, Species #8 characterized by figures 8 and 8A Species #9 characterized by figure 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

Art Unit: 3739

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Mr. James Robinson (Reg. No. 34,912) on September 23, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 3739

Applicant's election without traverse of species #1, drawn to claims 1-13 and 21-27 in Paper No. 8 is acknowledged.

Claims 14-20 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

**It should also be noted that claims 10-12 and 27 are directed to non-elected species and are hereby withdrawn from further consideration.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 13 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (5,507,794).

Regarding claims 1, 7, 8, 13 and 21, Allen discloses an elastic thermal wrap (10) comprising a first thermal portion (the first of 20) containing a thermal agent gel (42, see

Art Unit: 3739

col. 4, lines 8-25), a second thermal portion (the second of 20) containing a thermal agent (42), a first elastic sheet (10), a second elastic sheet (55) joined to the first elastic sheet to form a plurality of pockets (55) containing thermal agent and a closure means (12 and 13), see col. 2, line 52 through col. 4, line 52 and figures 1 and 2. Refer to col. 2, line 63 through col. 3, line 4 regarding elastic material of the sheets.

Regarding claims 2-6 and 22-26, Allen further discloses an elastic thermal wrap having material made of either Lycra®, Spandex and Nylon which have the stretching properties recited by the claimed invention, namely at least a 200% stretch upon application of force and a return to within 5% of the original length once the force is removed, see col. 2, line 63 through col. 3, line 4.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (5,507,794) in view of Horning (USPN 6,582,383 B2).

Art Unit: 3739

Regarding claim 9, Allen discloses an elastic thermal wrap (10) comprising a first thermal portion (the first of 20) containing a thermal agent gel (42, see col. 4, lines 8-25), a second thermal portion (the second of 20) containing a thermal agent (42), a first elastic sheet (10), a second elastic sheet (55) joined to the first elastic sheet to form a plurality of pockets (55) containing thermal agent and a closure means (12 and 13), see col. 2, line 52 through col. 4, line 52 and figures 1 and 2. Refer to col. 2, line 63 through col. 3, line 4 regarding elastic material of the sheets. However, Allen fails to teach providing a third thermal portion containing a thermal agent. However, Allen does state “without departing from the spirit and scope of this invention, one of ordinary skill may make various changes and modifications to the invention to adapt it to various usages and conditions,” see col. 4, lines 47-50. It is well known in the art to provide more than two thermal portions in order to provide more thermal coverage. As an example, Horning discloses a thermal bandage that provides cold or heat and teaches the provision 3 or more thermal portions in order to provide maximum heat transfer to a particular body part, col. 2, line 47 through col. 3, line 31 and figures 1b, 2, 4-8. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Allen, as taught by Horning, to provide 3 or more thermal portions in order to provide maximum heat transfer to a particular body part.

Art Unit: 3739

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pyrozyk et al. disclose a thermal bandage having many of the features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A.R. *A.R.*  
November 13, 2003



**ROSILAND K. ROLLINS  
PRIMARY EXAMINER**